

REMARKS

Claim Amendments

Claims 29-33, 37-40, 42-44, 46-48, 50-70 are currently pending in the application. Claims 1-36 and claims 39-70 are canceled without prejudice. Claim 38 is newly amended, incorporating the limitations of now canceled claim 40. Support for claims amendments is found throughout the specification and in the originally filed claims and are discussed in the relevant sections below. No new matter is added.

Specification

The Examiner suggests that figures containing text concerning differential expression of genes in OA be incorporated as TABLES into the specification so as to make the information more search-accessible to the public in the event this application issues as a patent.

Applicant has considered incorporating as TABLES into the specification text concerning differential expression of genes in OA, upon the indication of allowable claims. However, Applicant has decided not to convert the drawings of the instant application into tables. Applicant notes that the issued claims are limited to a method comprising two biomarkers.

Claim Objections

The Examiner objects to claim 64 on the grounds that the term "RT-PCR" is misspelled. Applicant has canceled claim 64, thereby rendering the objection moot. In view of this amendment, Applicant respectfully requests reconsideration and withdrawal of the objection.

35 U.S.C. § 112 Rejections

Indefiniteness

Claim 62 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 62 has been canceled, thereby rendering the objection moot. In view of this amendment, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Enablement

Claims 38-39, 42-44, 46-48, 50-52 and 62-64 are rejected under 35 U.S.C. § 112, first paragraph, because according to the Examiner the specification, “while enabling for a method of diagnosing mild osteoarthritis in a human test individual, said method comprising (a) for each gene of a set of genes consisting of TNFAIP6 and TGFBI, determining a level of expression of RNA encoded by said gene in a cartilage sample of a test individual, (b) for each gene of said set of genes, comparing the level of expression of said RNA in said sample of said test individual with a level of expression of RNA encoded by said gene in control cartilage samples obtained from each of the following populations: (i) human individuals not having osteoarthritis, (ii) human individuals having mild osteoarthritis, (iii) human individuals having moderate osteoarthritis, (iv) human individuals having marked osteoarthritis, and (v) human individuals having severe osteoarthritis does not reasonably provide enablement for a method of diagnosing any stage of osteoarthritis using any other set of genes or a method of diagnosing moderate, marked or severe osteoarthritis by determining the level of TNFAIP6 and TGFBI expression” (p.6 of Final Office Action dated April 19, 2007), .

Applicant respectfully traverses the rejection that in view of the breadth of the claims and the lack of guidance provided by the specification as well as the unpredictability of the art, the skilled artisan would have required an undue amount of experimentation to make and/or use the claimed invention.

However, in order to expedite prosecution, Applicant has cancelled the instant claims without prejudice, thereby rendering the instant rejection moot. In view of this amendment, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Allowable subject matter

Applicant appreciates the statement in the final office action that claim 38 is allowable and that claim 40 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Accordingly, Applicant has amended base claim 39 so that it includes the limitations of claim 40.

Conclusion

Applicant submits that all claims are allowable as written and respectfully requests early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney's/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney/agent of record.

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